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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/753,074      | 12/29/2000  | Scott W. Atkinson    | 046700-5032         | 3499             |

28977 7590 10/19/2006

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| EXAMINER |
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HAMILTON, LALITA M

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| ART UNIT | PAPER NUMBER |
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3691

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/753,074  | <b>Applicant(s)</b><br>ATKINSON ET AL. |  |
|                              | <b>Examiner</b><br>Lalita M. Hamilton | <b>Art Unit</b><br>3691                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Summary

On March 9, 2006, an Office Action was sent to the Applicant rejecting claims 1-30. On July 13, 2006, the Applicant responded by amending claims 1, 3, 25, and 28-29.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 and 20-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Merel (6,006,194).

Merel discloses a method and corresponding system and device for bidding rounds comprising creating a rule for a second auction round based on user input, the rule limiting participation of bidders in the second auction round based on an occurrence in a first auction round, conducting the first auction round having a first set of bidders, determining participation of bidders from the first set of bidders in the second auction round, in accordance with an application of the rule to the occurrence in the first auction round, and conducting the second auction round based on the determined participation (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the occurrence includes an outcome of the first auction round (col.1, lines 5-10; col.2, line

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55 to col.3, line 10; and col.9, line 50 to col.10, line 50); at least two rounds, wherein at least two bidders bid in the auction, creating a rule for a second auction round based on user input, the rule limiting participation of bidders in the second auction round based on an occurrence in a first auction round, conducting the first auction round having a first set of bidders, determining an outcome of the first auction round, determining participation of bidders from the first set of bidders in the second auction round in accordance with an application the rule to the outcome of the first auction round, and conducting the second auction based on the predetermined participation (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the rule includes selecting at least two leading bidders from the first auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the rule includes permitting only the at least two leading bidders to participate in the second auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the rule includes selecting a winning bidder from the first auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the rule includes not permitting the winning bidder to participate in the second auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); forming a rule for a second auction round precedes conducting said first auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the bidders are electronically coupled to an auction coordinator during the conducting of the first and second auction rounds (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the bidders submit bids to the auction coordinator online

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during the conducting of the first and second auction rounds (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the auction is a reverse auction (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50—can be any type of auction); the auction is a forward auction (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the bidders participate in a sealed bid in the first auction round and are electronically coupled to an auction coordinator online during the second auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); the rule includes permitting only bidders bidding less than a predetermined amount to participate in the second auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); awarding a contract to a bidder in the second auction round and conducting a third auction including only bidders that were not awarded a contract in the first auction round and bidders that were not awarded a contract in the second auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); determining that a bidder may participate in a second auction round if the bidder is a leading bidder in a first auction round, conducting the first auction round which includes a plurality of bidders, designating one or more of the plurality of bidders as non-leading bidders in accordance with the conducting of the first auction round, and conducting the second auction round that excludes the non-leading bidders from the first auction round (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50); and first bidder processor and said second bidder processor communicate through the Internet

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during the first and second auction rounds (col.1, lines 5-10; col.2, line 55 to col.3, line 10; and col.9, line 50 to col.10, line 50).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merel in view of Shoham (6,285,989).

Merel discloses the invention substantially as claimed; however, Merel does not disclose preparing a request for quotation, providing the request for quotation to potential bidders, and requesting that potential bidders respond to the request for quotation or request for quotation includes an identification of goods or services to be purchased. Shoham teaches a method and corresponding system and device for on-line auctions comprising preparing a request for quotation, providing the request for quotation to potential bidders (col.12, lines 38-65), and requesting that potential bidders respond to the request for quotation or request for quotation includes an identification of goods or services to be purchased (col.12, lines 38-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate preparing a request for quotation, providing the request for quotation to potential bidders, and requesting that potential bidders respond to the request for quotation or request for quotation includes an identification of goods or services to be purchased, as

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suggested by Shoham into the invention disclosed by Merel, to demonstrate that the methods of Merel may be used in a variety of auctions for goods and services.

***Response to Arguments***

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

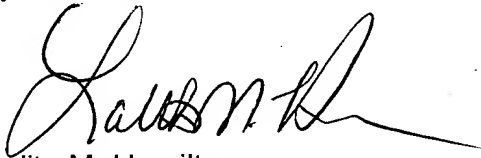
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lalita M. Hamilton  
Primary Examiner, 3691